

**RESTRICTION REQUIREMENT**

Applicant received a call from the Examiner Lauren Wells on March 12, 2003, wherein the Examiner made a telephonic Restriction Requirement between the following four groups of claims:

Group I: Claim 27, drawn to a process for shaping or holding a hairstyle;

Group II: Claim 28, drawn to a process for manufacturing a hairstyling product;

Group III: Claims 29-73, drawn to a dispenser device; and

Group IV: Claims 74-114, drawn to a hairstyling composition.

The Examiner further requested that Applicant elect a specific polycondensate and a specific film-forming polymer to be prosecuted. Applicant respectfully traverses the restriction requirement and election of species. To be fully responsive, however, on March 18, 2003, Applicant elected with traverse, Group I, claim 27, and conveyed that the species elected for the polycondensate and film-forming polymer on October 24, 2001, was to continue being prosecuted.

Applicant initially traverses the restriction/election requirement on the grounds that the Examiner has not shown that there would be a serious burden to examine the claims of Groups I-IV together, especially since the Examiner has acknowledged that two of the Groups are included in the same class, 424 (Groups I and IV). Moreover, Group II is directed to a process of making a product, such as recited in the claims of Group IV. Thus, the search and examination of Group I should include, and thus overlap a search for the subject matter of the other Groups. Accordingly, a serious burden to examine all the Groups together would not exist.

Thus, in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office, the restriction between Groups I and IV should be withdrawn.

Applicant respectfully requests that all the claimed species of compounds continue to be examined in this application. If the Examiner chooses to maintain the restriction/election requirement, Applicant expects the Examiner, if the elected species is found allowable, to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, i.e., extending the search to a reasonable number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

Applicant thanks the Examiner for extending the search and for indicating that claims limited to lactic acid/ethylene glycol P-dimethylolpropanoic acid-isophorone diisocyanate polyester polycondensate would be allowable. (Office Action at 3.)

#### **REJECTIONS UNDER 35 U.S.C. § 103**

A. The Examiner rejects claim 27 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,643,581 to Mougin et al. in combination with the Handbook of Cosmetic Science and Technology.<sup>1</sup> (Office Action dated April 11, 2003, at 4.)

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<sup>1</sup> The Office Action does not identify the U.S. Patent Number for Mougin. Because the prosecution history cites two Mougin patents, Applicant telephoned the Examiner for clarification as to which patent she was using as a basis for her rejection. Examiner Wells informed the undersigned on July 1, 2003, that she was relying on U.S. Patent No. 5,643,581 to Mougin et al. as the basis for her rejections.

To establish a *prima facie* case of obviousness, the Examiner must establish that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Even if there is a motivation or suggestion, the prior art can be modified only if there is a reasonable expectation of success. M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001). Applicant respectfully traverses the rejections because the Examiner has failed to meet these criteria.

The Examiner relies on Mougin for teaching a cosmetic composition comprising at least one pseudolatex based on a multiblock polycondensate which contains a polysiloxane block and a polyurethane and/or polyurea block, wherein the polyurethane and/or polyurea block further comprises anionic or cationic groups. (*Id.* at 5.) The Examiner acknowledges that this reference fails to exemplify claim 27. (*Id.*) Apparently recognizing some of the many deficiencies in Mougin, the Examiner relies on the Handbook for teaching a definition for an aerosol and for showing that hairsprays conventionally have an average particle size of 50 micrometers. (*Id.*) In view of these teachings, the Examiner argues that it would have been obvious to exemplify an aerosol comprising polycondensate and film-forming agents having an average particle size of 50 micrometers because of the expectation of achieving an aerosolized setting spray that uniformly and quickly delivers the setting composition to hair. (*Id.* at 5-6.) The Examiner's bald assertion is not supported by technical or legal grounds. For example, the Examiner does not explain how the mixture of two compounds would necessarily result in an aerosol having the claimed particle size. The conclusory argument based on the definition of an aerosol does not remedy this deficiency.

Moreover, the Examiner appears to be ignoring the fact that claim 27 is a process claim comprising dispensing a hair composition using a dispenser device. For example, independent claim 27 is directed to a process for shaping or holding a hairstyle, comprising: dispensing a hair composition using a dispenser device, said dispenser device comprising a reservoir containing said hair composition; wherein (i) the composition comprises, in a cosmetically acceptable medium, at least one polycondensate (A) comprising at least one block chosen from polyurethane and polyurea blocks and at least one film-forming polymer (B); and (ii) the at least one polycondensate (A), the at least one film-forming polymer (B), and the device being chosen so as to obtain, on leaving the device, droplets of said hair composition with an average diameter of less than or equal to 80  $\mu\text{m}$ .

Rather than support her arguments with facts or the law, the Examiner's rejection is based on selective picking and choosing from the references in order to create the claimed invention, while impermissibly ignoring the art as a whole. *In re Wesslau*, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965). In particular, the Examiner has picked parts of Mougins that appear to teach certain aspects of the claimed hair composition. The Examiner has then picked a definition out of the Handbook for an aerosol. However, the combination of these teachings from the references does not amount to a teaching or suggestion to modify Mougins's teaching of a composition into the claimed process for shaping or holding a hairstyle.

Additionally, the Examiner has failed to point to the particular teaching or suggestion in either reference wherein one of ordinary skill in the art would specifically select the claimed at least one polycondensate (A), the at least one film-forming

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polymer (B), and the device so as to obtain, on leaving the device, droplets of said hair composition with an average diameter less than or equal to 80  $\mu\text{m}$ . While the Handbook teaches that hairsprays conventionally have an average particle size of 50 micrometers, this does not rise to the level of a specific teaching or suggestion to make particular selections with regard to components of the hair composition and the device so that particular size droplets of hair composition are formed upon leaving the device. Indeed, as taught on pages 2-3 of the specification, Applicant recognized that a problem with prior art spray compositions is that they resulted in a product that was difficult to uniformly apply to the hair due to the large particles leaving the device.

The references, at most, separately teach individual elements of the claimed invention; however, no reference teaches or suggests the process comprising using a dispensing device with the claimed hair composition in order to achieve droplets, on leaving the device, having a certain average diameter. The Examiner has not cited on the record the specific teaching or suggestion that would have motivated one of ordinary skill in the art to make all the specific selections needed to arrive at the claimed invention. Furthermore, by merely throwing out the definition of an aerosol, the Examiner has not met her burden of showing that one would expect a particular combination of components to successfully achieve a particular particle size upon leaving a device.

For at least these reasons, the references, alone or in combination, do not render obvious the claimed invention. Reconsideration and withdrawal of the rejection are respectfully requested.

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B. The Examiner also rejects claim 27 under 35 U.S.C. § 103(a) over Mougin in combination with the Handbook, both in view of U.S. Patent No. 6,423,297 to Samain et al. (Office Action dated April 11, 2003, at 6.) Applicants respectfully traverse the rejection.

For the reasons discussed above, the combination of Mougin and the Handbook, would not have rendered obvious the claimed invention. Samain does not cure the fundamental deficiencies discussed above. In fact, the Examiner merely relies on Samain for teaching polydimethyl/methylsiloxane containing propylthio-3-methacrylate groups/methacrylate/methacrylic acid as a film-forming polymer that has good fixing/shaping qualities and provides excellent cosmetic properties such as softness, disentangling and good feel to the hair. (*Id.* at 7.)

Applicant respectfully submits that Samain is not applicable prior art and thus, this rejection is improper. M.P.E.P. §706.02(I)(1). 35 U.S.C. §103(c) states that effective November 29, 1999, subject matter which was prior art only under 35 U.S.C. §102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

The present application was filed on October 3, 2000, and thus, is subject to 35 U.S.C. §103(c). Samain et al. issued on July 23, 2002, i.e., after the priority date of the present application, and thus, can only be prior art against the present application under §102(e). Further, this reference is assigned to L'Oréal, as evidenced by the assignment information on the face of the patent. The present application is also assigned to L'Oréal, as indicated by the attached copy of the executed assignment filed in this case

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and Notice of Recordation of Assignment. In addition, Applicant notes that the present application and Samain et al. were, at the time the present invention was made, assigned to or under an obligation of assignment to L'Oréal. Accordingly, Samain et al. is not applicable prior art under §103, and the rejection over this reference is therefore improper.

**CONCLUSION**

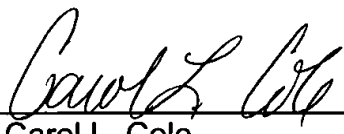
In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: September 11, 2003

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Attachments

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